

REMARKS

This Amendment is in response to the Examiner's non-final Office Action of September 6, 2007. The rejections in that Office Action have been carefully considered.

All of the rejections in the Office Action are obviousness rejections under 35 U.S.C. 103 based at least on "HBCI HOMEBANKING COMPUTER INTERFACE - Interface Specification - Version 2.1" (hereafter, "HBCI Version 2.1"). In light of the Rule 131 declaration submitted herewith, and for other reasons, more specifically discussed below, the rejections are respectfully traversed, and reconsideration and withdrawal of the rejections is respectfully requested.

This application is a national stage application of PCT Application No. DE00/00792 filed on March 15, 2000, which in turn claimed the priority of German Patent Application No. 199 11 782.9 filed on March 17, 1999. A certified copy of the German priority document was filed in this application and has been received in this national stage application from the International Bureau. HBCI Version 2.1 was published no earlier than March 2, 1999, only fifteen days before applicants' claimed priority date.

Applicants have obtained and submit simultaneously herewith a Declaration under 37 CFR 1.131. The Declaration states and the attached documents show that the invention of the subject matter of the rejected claims by applicants was prior to the March 2, 1999 publication date of HBCI Version 2.1. Furthermore, the attached correspondence shows that the invention report was forwarded to a patent attorney, Dr.-Ing. Peter Riebling, in Germany for preparation of the priority application ultimately filed on March 17, 1999.

It therefore respectfully requested that the obviousness rejections based in part on HBCI Version 2.1 be withdrawn in view of the evidence showing that the claimed subject matter was

invented before the publication date of HBCI Version 2.1. Therefore, the obviousness rejections under 35 USC 103(a) should be withdrawn at least for this reason.

Claims 1, 20-28, 30-31, 34, 36 and 37 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 6,868,391 to Hultgren in view of HBCI Version 2.1 and "At the Coal-face Between Financial Industries and Politics" (hereafter, the "Interview Reference"). Of these rejected claims, only claims 1 and 37 are independent. All other rejected claims depend directly or indirectly on claim 1. The specific grounds of rejection and rationale is set forth in part 3 on pages 2-9 of the Office Action.

The rejection has essentially taken the position that Hultgren teaches all of the elements of independent claims 1 and 37, except that it "used the telepay gateway between the bank and the GSM mobile network instead of a HBCI gateway." The rejection asserts that it would have been obvious at the time the invention was made "to make use of HBCI gateway instead of Telepay gateway of Hultgren as design preference . . . in order to perform Internet banking with European banks over GSM network." In addition to the Rule 131 declaration submitted herewith, the rejection is respectfully traversed for further reasons more specifically discussed below, which reasons would still be applicable even if HBCI Version 2.1 was available for use as prior art.

Hultgren discloses a tele/data-communications payment method and apparatus that is intended to allow payments or transfers from a customer account of a customer financial institution or bank to a merchant account of a merchant financial institution when making purchases. However, the patent seems to be mostly limited to obtaining transaction verification requests from a customer mobile station and, upon receipt of such verification, to the request of TSN 30 for the transfer from the customer account to the merchant account. While Hultgren

discloses some of the limitations of independent claims 1 and 37, it does not expressly disclose making use of a HBCI gateway, as the rejection has conceded.

The rejection asserts that the Interview Reference indicates a design preference for using the HBCI gateway instead of the Telepay gateway of Hultgren. First, the Interview Reference does not even mention the Telepay system of Hultgren. It does not express a "design preference" for replacing any part of the Telepay system with an HBCI gateway. The method of Hultgren is primarily a payment system between customer and merchant; and the HBCI standard, in contrast, allows the customer not only to make payments but also to use a plurality of banking services and activities.

Secondly, the Interview Reference mentions the HBCI standard in response to one question and, in response to the next question, says that "the Internet (IP) is a standard, and I think that ultimately all of of the IT infrastructure will migrate to that standard. So you are going to have . . . internet GSM banking...". The Interview Reference says nothing about using an HBCI gateway such as that of the claimed invention. Even assuming for the sake of argument that the Interview Reference suggests attempting to implement HBCI through an Internet connection over a GSM cellular network, there is no indication as to how this is done. Thus, one of ordinary skill in the art would attempt to implement HBCI over some conventional Internet connection "ultimately" specified for a GSM cellular network.

Specifically, there is no suggestion of the claimed subject matter which requires an HBCI gateway, and splitting of the customer end HBCI system into two components, the SIM card of the mobile station and an HBCI Gateway. Indeed, it is the inventors of this application who decided that straightforward implementation of HBCI over GSM was not feasible because it is too extensive in terms of data transmission bandwidth, storage capacity and computing power for

a direct projection onto the GSM mobile telephone world (see page 2, lines 1-4, of the specification), and who therefore developed the particular invention recited in the claims (see page 2, lines 5-22). Of course, new claim 38 is allowable for this same reason even though it does not contain any recitation of HBCI.

It is believed that the Rule 131 Declaration and/or above arguments overcome the rejections based on Version 2.1 of the HBCI specifications, and that the rejections should be reconsidered and withdrawn. The application is believed to be in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited.

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. The fee for the additional claim, and any extension fee or other fee necessary for the consideration of this Amendment, may be charged to Deposit Account No. 10-0100 (Dkt. No. Rieb.P-44).

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LACKENBACH SIEGEL
One Chase Road, Scarsdale, NY 10583
Tel.: (914) 723 4300

Respectfully submitted,

LACKENBACH SIEGEL LLP
Attorneys for Applicant(s)

By: 
Robert M. Bauer, Reg. No. 34,487